

Appl. No. 10/064,283
Amdt. Dated 10/16/2003
Reply to Office action of 09/03/2003

REMARKS/ARGUMENTS

In the specification, the paragraph [003] beginning at page 1 has been amended for the sake of clarity. No new matter has been added.

Claims 1-18 remain in this application.

Claims 1- 18 fully comply with USC § 103 (a)

Applicants respectfully traverse the rejection of claims 1-18 under 35 USC 103(a) over Basu and also over Basu in view of Modell. Applicants respectfully submit that the applied references do not teach, suggest, or disclose (individually or in combination) the independent claims 1, 6, 11 and 16.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the applicant's disclosure.**

With respect to the Basu rejection, Applicant interprets the Office Action as stating that it is a matter of obvious design choice to select a known material on the basis of its suitability for the intended use (page 3, first full paragraph). The Office action further states on page 4, paragraph 4, second sentence, "Applicant argument Basu is not persuasive since it is well known in the art to chose bristle material, evidence shown by Modell". Applicant respectfully traverses these statements and submits that selecting the material as taught by the Applicant is not known in the art. In fact, it is a conventional practice established in the art to use Cobalt based materials, such as the Haynes alloy, which is the prevalent industry standard for brush seal bristles. Applicant submits that one having ordinary skill in the art would have no motivation to use a material different from the prevalent and established industry standard.

With respect to the Basu and Modell rejection, the Office action suggests that it would have been obvious to replace the bristles used for sealing as taught by Basu, with the bristles used for cleaning as taught by Modell (Inconel 625 or Hastelloy C-276). However, [I]t is immaterial to the issue of obviousness that elements of the claimed invention exist in other contexts. The Gillette Co. v. S.C. Johnson & Son Inc., 16 U.S.P.Q.2d 1923, 1927 (Fed. Cir. 1990). Applicant submits that there exists **no reasonable expectation of success** when using a cleaning bristle in a sealing context. If there is no reasonable expectation of success, there exists **n motivation** to combine the two references.

Accordingly, Applicant respectfully traverses the rejection of claims 1, 6, 11 and 18 on the grounds that a prima facie case has not been established.

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Accordingly, Applicant respectfully submits that the claimed invention defines allowable subject matter over the applied art. Withdrawal of the rejections is respectfully requested, and allowance of the claims is respectfully solicited.

Claims 2-5, 7-10, 12-15 and 17-18 depend directly or indirectly from claims 1, 6, 11 and 16 respectively. Applicant respectfully submits that claims 1, 6, 11 and 16 are patentably distinct from the applied references for the reasons discussed above and that claims 2-5, 7-10, 12-15 and 17-18 are similarly allowable over the applied references.

Summary

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Should the Examiner believe that anything further is needed to place the application in even better condition for allowance, the Examiner is requested to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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Attachments: None

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